

REMARKS

In the Office Action it was asserted that "[a]pplicants' preliminary amendment, filed 02.01.02, is not signed by the Applicants' Representative. A signed copy is required." (Paper No. 12 at 3.) A copy of the Office Action is attached hereto as Exhibit 1.

During the teleconference of May 22, 2003, Ms. Pettus acknowledged that the PTO does not have the last page of the Preliminary Amendment, which contains the signature block.

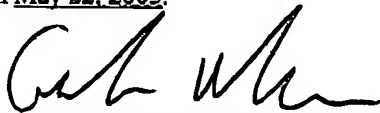
As indicated by the postcard returned to Applicants, the Preliminary Amendment as filed contained **20 pages**, not 19, as indicated by Ms. Pettus. Accordingly, we can only conclude that the PTO has misplaced the signature page.

As a courtesy to the Office, we enclose a copy of the Preliminary Amendment as filed on February 1, 2002 (attached hereto as Exhibit 2), including the returned postcard evidencing receipt by the PTO of all **20 pages** of the Preliminary Amendment (attached hereto as Exhibit 3).

In view of the foregoing, favorable action on the merits, including consideration and entry of the amendments prior to examination on the merits, respectfully is requested.

If the Examiner wishes to discuss any part of this submission, please contact the undersigned.

I hereby certify that this correspondence is being transmitted to the United States Patent Office via facsimile transmission at (703) 308-4407 and addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA. 22313-1450, Attn: Examiner T. Saidha, on May 22, 2003.



Gonzalo Merino, Ph.D. Reg. No. 51,192

Respectfully submitted,

By: 

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EXHIBIT 1



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,848	02/01/2002	Dirk Kostrewa	13232 US2 (C38435/128425)	5651

7590

05/06/2003

Stephen M. Haracz, Esq.
BRYAN CAVE LLP
245 Park Avenue
New York, NY 10167-0034

EXAMINER

SAIDHA, TEKCHAND

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 05/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

10/11/03
C38435/128425

5/12/03
AY

Office Action Summary

Application No.

10/662846

Applicant(s)

Kostrowa et al.

Examiner

T. Sankha

Group Art Unit

1652

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 06 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Telephone call 3/10/03
- ☒ Responsive to communication(s) filed on 3/10/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-24 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-24 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a process of designing and producing a modified phytase, classified in class 435, subclass 471.
 - II. Claims 12-15 and 24, drawn to a modified *Aspergillus* phytase, classified in class 435, subclass 196.
 - III. Claims 16-23, drawn to DNA encoding a modified phytase and transformed host cells classified in class 435, subclass 325.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different process such as a phytase produced by a mutagenized *Aspergillus*.
3. Inventions of Group I and Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different process such as by random mutagenesis.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. A telephone call was made to Mr. Gonzalo Marino on 3.10.03 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. PRELIMINARY AMENDMENT -

Applicants' preliminary amendment, filed 02.01.02, is not signed by the Applicants' Representative. A signed copy is required.

Application/Control Number: 10/062848

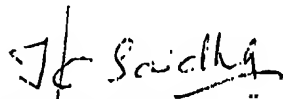
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha (Ph.D.) whose telephone number is (703) 305-6595. The examiner can normally be reached on Monday-Friday from 8:15 am to 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group in the Technology Center is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Tekchand Saidha
Primary Examiner, Art Unit 1652
March 10, 2003



UNITED STATES
PATENT AND
TRADEMARK OFFICE

FEB 20 2003

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

Dear Patent Business Customer:

The United States Patent and Trademark Office ("Office") is now permitting and encouraging applicants to voluntarily submit amendments in a revised format as set forth in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, Off. Gaz. Pat. Office (February 25, 2003), currently available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>. The revised format permits amendments to the specification and claims to be made in a single marked-up version; the requirement for a clean version is eliminated. Attached, you will find a flyer with information and instructions regarding the procedures to be used to comply with the revised format. The flyers are being inserted with out-going Office actions mailed during the period of February 20, 2003 - March 31, 2003.

The revised amendment format is essentially the same as the amendment format for the specification, claims, and drawings that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. This proposed revision and others necessary to facilitate a gradual transition to the use of an Electronic File Wrapper (EFW) will be set forth in a Notice of Proposed Rule making (NPR), expected to be published by March 2003. After consideration of public comments, the Office anticipates adopting a revision to § 1.121, following publication of a Notice of Final Rule making (NFR), expected by June 2003, at which point compliance with revised § 1.121 will be mandatory.

The Office will continue to accept your amendment submissions in the revised format during the voluntary period, which will extend up to the effective date of final revisions to § 1.121. The Office also encourages your feedback on the proposed revised amendment format and other changes set forth in the NPR, expected to be published by March 2003.

For assistance: Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA), Legal Advisors Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). Alternately, you may send e-mail to "Patent Practice", the OPLA e-mail address that has been established for receiving queries and questions about patent practice and procedures or telephone OPLA at (703) 305-1616.

Nicholas P. Godici
Commissioner for Patents

Attachment: Flyer entitled: *Revised Notice* AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT*

EXHIBIT 2